

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI ABIKO

Appeal No. 2004-1362
Application No. 09/926,600

HEARD: August 17, 2004

Before KIMLIN, TIMM and JEFFREY T. SMITH, **Administrative Patent Judges**.
JEFFREY T. SMITH, **Administrative Patent Judge**.

ON REQUEST FOR REHEARING

Appellant has filed a paper under 37 CFR § 41.52 (a)(1)¹ requesting that we reconsider our decision of September 29, 2004.

¹ Effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004).

Appeal No. 2004-1362
Application No. 09/926,600

37 CFR § 41.52 (a)(1) (2004) provides as follows:

Appellant may file a single request for rehearing within two months from the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

We have reconsidered our decision of September 29, 2004, in light of Appellant's comments in the request for rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision for the reasons which follow.

Appellant asserts that the Board has misapprehended or overlooked the argument that Fujisawa teaches away from using a Cr content exceeding 60 wt%. Appellant argues that Fujisawa teaches a Cr content of up to 60 wt% and there is no overlap with the claimed Cr content exceeding 60 wt%.

Appeal No. 2004-1362
Application No. 09/926,600

(Rehearing request p. 3). Appellant further argues that Fujisawa teaches that the addition of Cr in excess of 60 wt% is undesirable because of insufficient workability, increased cost and insufficient improvement in the acid resistance. (Rehearing request pp. 3-4).

These are essentially the same arguments Appellant presented in the Brief and Reply Brief. These arguments were addressed on pages 5 and 6 of our decision. As stated on page 5 of our decision, "[t]he Federal Circuit has held that a *prima facie* case of obviousness exists when the claimed range and the prior art range do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985)." When the Examiner has met the initial burden of providing references which suggest the claimed invention the burden is on the Appellant to prove that the invention described by the prior art does not necessarily or inherently possess characteristics attributed thereto.

Appellant argues that Fujisawa teaches away from using Cr in excess of 60 wt% because of insufficient workability, increased cost and insufficient improvement in the acid resistance. However, Appellant has not presented evidence to support his argument that the undesired characteristics occur

Appeal No. 2004-1362
Application No. 09/926,600

when there are minor increases in the Cr content as suggested by the Examiner. Contrary to Appellant's argument, the Examiner has not improperly placed the burden of production of evidence on the Appellant. Appellant has raised the unsupported argument that increases in the Cr content would have undesired properties.²

A person of ordinary skill in the art would have reasonably expected that an alloy having a Cr content slightly above 60 wt% would perform as disclosed by Fujisawa. Further, Appellant has not directed us to evidence that minor increases in the amount of Cr above 60 wt%, such as identified by the Examiner, would have resulted in poor workability and insufficient improvement in the acid resistance.

In light of the foregoing and for the reasons expressed in our decision, it is our determination that the Examiner has established a *prima facie* case of obviousness with respect to the argued claims on appeal.

We have granted Appellant's request to the extent that we have reconsidered our decision of September 29, 2004, but we deny the request with respect to making any changes therein.

²Unsupported arguments of counsel cannot take the place of evidence. See *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Appeal No. 2004-1362
Application No. 09/926,600

Time for taking action

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

REHEARING REQUEST DENIED

Edward C. Kimlin
EDWARD C. KIMLIN
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge


JEFFREY T. SMITH
Administrative Patent Judge

**BOARD OF PATENT
APPEALS
AND
INTERFERENCES**

JTS/gjh

Appeal No. 2004-1362
Application No. 09/926,600

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191